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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/827,670

Applicant(s)

BRODY, MOSHE

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04052001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-28 are pending.

***Specification***

2. The abstract of the disclosure is objected to because it is longer than the allowed 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-14, 16, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 13-14 recite the limitation "said personalization verification module" in lines 1-2 (of claim 13) and lines 2-3 (of claim 14). There is insufficient antecedent basis for this limitation in the claim. Hereinafter "said personalization verification module" will be considered "said personalization validation module".

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6. The term "an authentication" in claim 16 is a relative term which renders the claim indefinite. The term "an authentication" is not specifically defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examination of this claim based on prior art "an authentication" will be the authenticated personalization as described on page 65 of applicant's specification.

7. Any claims not specifically addressed are rejected by virtue of their dependencies.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 10-15, 17, 21, 23-24, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Moskowitz et al (U.S. 5,745,569).

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As per claim 1, Moskowitz et al discloses an arrangement for software protection comprising a personalization, said personalization incorporated into the information stream by the software publisher and containing pre-existing personal information fundamentally related to the customer (see column 6 lines 9-37 where the information stream is the computer code).

As per claim 2, Moskowitz et al discloses the deliverable software is intended to execute on a plurality published of computers, and wherein said personalization is not fundamentally related to any specific computer of the plurality (see column 6 lines 9-37).

As per claim 3, Moskowitz et al discloses the deliverable published software is intended to execute on a plurality of computers, each of the plurality of computers having a configuration, and wherein said personalization is not fundamentally related to any specific configuration (see column 6 lines 22-31).

As per claim 4, Moskowitz et al discloses the deliverable published software is intended to execute on computers belonging to a class of computer, and wherein the deliverable published software executes in substantially identical functional form on substantially all computers of the class of computer (see column

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2 lines 45-60 where it is inherent of Java to execute substantially identical on all computers).

As per claim 5, Moskowitz et al discloses the personalization is not associated with, and does activate, any usage restriction on the deliverable published software (see column 6 lines 9-37).

As per claim 6, Moskowitz et al discloses the personalization does not have a fixed address within the information stream (see column 6 lines 9-37).

As per claim 7, Moskowitz et al discloses the personalization does not have a fixed extent within the information stream (see column 6 lines 9-37).

As per claim 10, Moskowitz et al discloses the information stream contains at least one executable module operative to displaying at least part of said personalization (see column 6 lines 22-31 where it is inherent that the information will be displayed when being entered).

As per claim 11, Moskowitz et al discloses the information stream contains at least one executable module, and wherein said personalization is contained within said at least one executable module (see column 6 lines 9-37).

As per claim 12, Moskowitz et al discloses a personalization validation module operative to validating a

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personalization (see column 6 lines 38-67 where extracting the watermark is the validation and the key is part of the personalization).

As per claim 13, Moskowitz et al discloses the personalization validation module is further operative to validation an output file (see column 6 lines 38-67 where the software is an output file and the watermark is used to validate it).

As per claim 14, Moskowitz et al discloses the information stream contains at least one executable module, and wherein said personalization verification module is further operative to validating said at least one executable module (see column 6 lines 9-67).

As per claim 15, Moskowitz et al discloses the personalization validation module is further operative, upon not detecting a valid personalization, to initiate an action included in the group containing: (a) program termination; (b) operating the software in a demonstration mode; and (c) operating the software in a restricted mode (see column 6 lines 38-67).

As per claim 17, Moskowitz et al discloses at least part of the deliverable published software is written in the Java language (see column 2 lines 45-60).

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As per claim 21, Moskowitz et al discloses the personalization is in an encrypted form within the information stream, and wherein said personalization validation module is further operative to decrypting said encrypted form (see column 6 lines 9-37).

As per claim 23, Moskowitz et al discloses the information stream contains at least one executable module operative to writing an output file containing information derived from said personalization (see column 6 lines 9-37).

As per claim 24, Moskowitz et al discloses (a) obtaining pre-existing personal information fundamentally related to the customer; (b) producing, from said pre-existing personal information fundamentally related to the customer, a personal information module; and (c) producing an executable module deriving at least in part from said personal information module and incorporating said pre-existing personal information fundamentally related to the customer (see column 6 lines 9-37).

As per claim 28, Moskowitz et al discloses (a) a personal information collector for collecting pre-existing personal information fundamentally related to the customer; (b) a personalization compiler, for producing, from said pre-existing personal information fundamentally related to the customer, a personalization module; and (c) an executable module builder,

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for producing deliverable published software containing said pre-existing personal information fundamentally related to the customer and derived at least in part from said personalization module (see column 6 lines 9-37).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-9, 16, 20, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al as applied to claims 1 and 24 above, and further in view of Menezes et al (Handbook of Applied Cryptography).

As per claim 8, Moskowitz et al fails to disclose authenticating the personalization.

However, Menezes et al teaches authentication (see page 25).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's authentication on the personalization.

Motivation to do so would have been to verify that the information that was created by a user is actually from the user and that it hasn't changed (see Menezes et al page 25).

As per claim 9, the modified Moskowitz et al and Menezes et al method discloses the personalization is in an encrypted form within the information stream (see Moskowitz et al column 6 lines 9-21).

As per claim 16, the modified Moskowitz et al and Menezes et al method discloses the information stream contains at least one executable module having an authentication, and wherein said executable module executes in a secure computer environment operative to validating the authentication (see Moskowitz et al column 6 lines 38-67 where the watermark is verifying the authenticated personalization).

As per claim 20, the modified Moskowitz et al and Menezes et al method discloses the computer environment operative to executing Java software (see Moskowitz et al column 2 lines 45-60).

As per claim 25, the modified Moskowitz et al and Menezes et al method discloses (d) authenticating said personal

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information module (see Menezes et al page 25 applied to the personalization of Moskowitz et al column 6 lines 9-37); and (e) providing a personalization validation module, from which derives at least in part said executable module (see Moskowitz et al column 6 lines 38-67).

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al as applied to claim 21 above, and further in view of Menezes et al.

As per claim 22, Moskowitz et al fails to disclose the use of a public key cryptosystem for encryption and decryption for validation.

However, Menezes et al teaches the use of a public key cryptosystem (see pages 25-27).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's public key cryptosystem in Moskowitz et al's method.

Motivation to do so would have been that public/private key pairs could remain unchanged for long periods of time (see Menezes et al page 31).

13. Claims 18-19, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al as applied to claims 17 and 24 above, and further in view of Sommerer (The Java Archive (JAR) File Format).

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As per claim 18, Moskowitz et al fails to disclose the deliverable published software being contained in a Java archive.

However, Sommerer teaches the use of a JAR file (see Sommerer).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Sommerer's JAR file to hold Moskowitz et al's computer code.

Motivation to do so would have been that the JAR format allows for compression (see Sommerer page 1).

As per claim 19, the modified Moskowitz et al and Sommerer method discloses the JAR file is signed (see Sommerer page 1).

As per claim 26, the modified Moskowitz et al and Sommerer method discloses (d) incorporating said executable module within a Java archive; and (e) authenticating said Java archive with an archive signature (see Sommerer page 1).

14. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Moskowitz et al and Menezes et al method as applied to claim 25 above, and further in view of Sommerer.

As per claim 27, the modified Moskowitz et al and Menezes et al method fails to disclose (d) incorporating said executable

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module within a Java archive; and (e) authenticating said Java archive with an archive signature.

However, Sommerer teaches (d) incorporating said executable module within a Java archive; and (e) authenticating said Java archive with an archive signature (see page 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Sommerer's JAR file to hold the modified Moskowitz et al and Menezes et al's computer code.

Motivation to do so would have been that the JAR format allows for compression (see Sommerer page 1).

### **Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barton (U.S. 5,646,997) discloses a method for embedding authentication data and meta-data within digital data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be

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reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

Andrew Caldwell  
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